



HSM IP Trade Mark Client Guide

US VIRGIN ISLANDS

Registration

A trade mark can be registered in the US Virgin Islands pursuant to the *Regulations regarding Patents, Trademarks & Copyrights in the Virgin Islands of the United States*, as amended (approved 11 June 1959) issued in accordance with Section 11 of the *Revised Organic Act of 1954* (which functions as a constitution for territories of the US) which provide for applications to extend rights under an existing US registration.

The following information and documentation is required:

1. certified copy of the US Certificate of Registration
2. one copy of the mark (unless mark is word only)

It usually takes about three months for the Office of the Lieutenant Governor through the Division of Corporations and Trademarks (which serves as the Registry) in St. Thomas or St. Croix to process an application for registration. Paris Convention priority cannot be claimed. Once the registration is complete the Office will issue a Certificate of Registration.

Classes

The International Classification system is used. Multi-class applications are allowed. The application, however, is restricted to the number of classes specified on the US Certificate.

Searches

It is generally not necessary to conduct a search in the US Virgin Islands to ascertain that there will be no difficulty with the application for registration because of the requirement that there be a pre-existing US registration. If, however, a search is required, it can only be conducted using the registration number of the underlying US trade mark. The result can usually be provided within 2-3 weeks.

Renewal

A trade mark registration is valid for the same period as specified on the underlying US registration on which it is based.

The registration can only be renewed in the US Virgin Islands once the US registration has been renewed.

Two months before the renewal date we will send you an Expiry Notice asking whether you wish us to renew the registration (and the US registration if necessary) or allow the mark to lapse. If the registration is to be renewed the only documentation required is a certified copy of the US Renewal Certificate.

It usually takes between 1-4 weeks for the Office to process an application for renewal. Once the renewal is complete the Office will issue a Renewal Certificate.

If you do not wish to renew the mark please inform us so that we can advise the Office accordingly.

Abandonment

Please inform us as soon as possible if you wish to abandon your trade mark or allow it to lapse so that we can update our records and advise the Office accordingly. This will avoid us sending out unnecessary Reminder Notices.

Assignment

Please inform us as soon as possible if the trade mark has been assigned so that we can file an application to record the assignment in the US Virgin Islands (and in the US if necessary). Before an assignment can be recorded in the US Virgin Islands it must first be recorded in the US.

To record the assignment of a trade mark registration the only documentation required is a certified copy of the US Certificate of Registration showing the assignment.

It usually takes between 1-4 weeks for the Office to process an application to record an assignment. Once the recording is complete the Office will issue a Certificate of Recording of Assignment.

Change of Particulars

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change in the US Virgin Islands (and in the US if necessary). Before a change can be recorded in the US Virgin Islands it must first be recorded in the US.

To record a change of name and/or address for a trade mark registration the only documentation required is a certified copy of the US Certificate of Registration showing the change.

It usually takes between 1-4 weeks for the Office to process an application to record a Change of Particulars. Once the recording is complete the Office will issue a Certificate of Recording showing the change.

Our Firm

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other offshore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, CITMA, MARQUES and IPCA.

Contact Us

E-mail: ip@hsmoffice.com
Web: www.hsmoffice.com
Mail: PO Box 31726, Grand Cayman KY1-1207, Cayman Islands.
Courier: HSM, 68 Fort Street, George Town, Grand Cayman, Cayman Islands.
Tel: +1 (345) 949-4766

HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).

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